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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/558,236	04/24/2000	Alan Edward Kaplan	Kaplan 111711	8648

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EXAMINER	
ZAND, KAMBIZ	
ART UNIT	**PAPER NUMBER**
2132	6

DATE MAILED: 04/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/558,236	KAPLAN, ALAN EDWARD	
	Examiner	Art Unit	
	Kambiz Zand	2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 March 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *8* is/are allowed.

6)☒ Claim(s) *1-4,7 and 9-19* is/are rejected.

7)☒ Claim(s) *5 and 6* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *05 March 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. The text of those sections of Title 35,U.S.Code not included in this section can be found in the prior office action.
2. The prior office actions are incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.
3. Claims 5 and 8-17 have been amended.
4. Claims 18 and 19 have been added.
5. Claims 1-19 are pending.
6. Examiner withdraws objection to the drawings and specification due to correction by the applicant.
7. Examiner withdraws objection of claim 8 due to correction by the applicant.
8. Examiner withdraws rejection of claims 9-14 under 35 USC § 101 due to correction by the applicant.
9. Examiner withdraws rejection of claims 8 and 16-17 under 35 U.S.C 112-second paragraphs due to correction by the applicant.
10. Examiner withdraws objection of claim 2 under 37 CFR 1.75 as being a substantial duplicate of claim 1 due to clarification by the applicant.

Response to Arguments

11. Applicant's arguments filed 03/05/04 have been fully considered but they are not persuasive with respect to claims 1-4, 7 and 9-19.

As per applicant's arguments with respect to claim 1 that "if Examiner choose to maintain the rejection, applicant respectfully requests a clear identification of (a)..(d)", Examiner refers Applicant to the followings remarks:

- Examiner considers (a) "the order list" as list of identification numbers, cryptographic keys that are stored in a database as it is indicated in col.7, lines 48-54.

- Examiner considers (b) "what is the interaction in the course of which the id is provided by the user, and what is that id" as when the mobile is turned on the user id is provided such as ESN, MIN in item s100 of fig.9 or a PIN that a user enter as disclosed in col.7, lines 32-38. the id is provided by identification number generator. Applicant's argument that ESN, MIN are not necessary the user id is not persuasive since any string of character and numbers that identifies a user is considered as an user id. As an example, a car's plate number not only identifies the car, but it also identifies the owner of the car. Examiner suggests a proper claim language such as a unique user identifier that is only known to a user and not the entity the user uses in order to validate the applicant's arguments.

- "In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "the one or more random numbers" and "the responsive strings of characters") are not recited in the rejected claims 1 and 19. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

As per Applicant's arguments with respect to claim 9, examiner refers Applicant to the following remarks:

- "In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "a card that is processor-less") are not recited in the rejected claim 9. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

- Col.13, lines 62-67 disclose hand-held password generator that is embodied as an authentication token or a secure id authentication token (smart card) as depicted in fig.10 (col.14, lines 1-5). Col.18, lines 38-49 disclose calling cards or debit cards. A table is the storage or space within the handheld that holds data such as the number displayed in fig.10.

Claim Rejections - 35 USC § 102

12. **Claims 1-4, 7 and 18-19** are rejected under 35 U.S.C. 102(e) as being anticipated by Owens et al (6,338,140 B1).

As per claims 1, 2 and 18-19 Owens et al (6,338,140 B1) teach a method executed by a provider of authorizing provision of service to a user (see abstract where authorization for placing of a call and its execution is being provided to a user by a service provider) comprising: a first step of interacting with said user to receive an ID from said user (see fig.9, item s100 where by powering a mobile telephone and interacting with it, a user id such as ESN, MIN is being received) and with a database to receive an ordered list of characters associated with said ID that were selected by said provider (see fig.9, item s120 where a dynamic PIN is being generated and this the characters in a dynamic format that is associated with the user ID since is being generated based on the receiving of the ESN and MIN of the user mobile device and where having a memory; col.7, lines 46-54 where a database mapping the identification to respective keys or random characters); a second step of interacting with said user to receive from said user information responsive to requests placed to said user in the course of said interacting (see fig.9, item s140-s200 where the request for placing a call and authentication of the user's random PIN according to the mapping database instruction such as calling profile numbers (see abstract) of col.7, lines 46-54 is being processed); and a third step of authorizing said provision of service when

being processed); and a third step of authorizing said provision of service when said information received in response to said requests corresponds to a subset of entries in said ordered list of characters that is associated with said requests placed to said user, provided that said service is permitted service for a user who provides said ID (see fig.9, item s220 and s240 where access to the service is granted). Also see abstract where dynamic PIN generator create keys randomly in order to avoid cloning phones and stealing telephone identities; col.7, lines 22-67; col.8-19 and col.20, lines 1-18 for more detailed description of the above limitations.

As per claim 3 Owens et al (6,338,140 B1) teach all limitation of claim 1 where said second step is taken before said first step (see col.9, lines 5-6 where the steps in claim 1 may be sequential, or independent steps and therefore the reversal of the steps 1 and 2 are allowed. Examiner suggests Applicant to specifically disclose the reversal steps base on the support in the specification in the claim language in a manner to distinguishes itself from the sequential and independent steps and routine branching programs, a well known tool in the art of software programming.

As per claim 4 Owens et al (6,338,140 B1) teach the method of claims 1 and 9 where said characters are taken from set {0-9, #, *} since it is the Examiner position that having the set of {0-9, #, *} on a telephone' key pad is inherent part of the art of telecommunication.

As per claim 7 Owens et al (6,338,140 B1) teach the method of claim 1 where said service comprises telecommunication service (see fig.2,5 and 8; col.13, lines 7-34 where the telecommunication service provide services to the subscriber).

Claim Rejections - 35 USC § 103

13. **Claims 9-17** are rejected under 35 U.S.C. 103(a) as being unpatentable over Owens et al (6,338,140 B1) in view of Applicant Admittance of Prior Art (AAPA).

As per claim 9 Owens et al (6,338,140 B1) teach a card characterized by a table of characters (see fig.10; col.62-67 and col.14, lines 1-5 where the token or calling card having a tables ID to MIN relation table and MIN to cryptographic key relation table in col.15-16) but do not disclose explicitly a calling card. However AAPA in page 1 of the specification admit that calling card is disclosed in prior art. It would have been obvious to one of ordinary skilled in the art at the time the invention was made to utilize calling card of prior art in Owen's dynamic Pin generator and its database mapping system in order to have a preventing cloning or stealing the calling card's id as disclosed in Owen's abstract.

As per claim 10 Owens et al (6,338,140 B1) teach the calling card of claim 9 where said table has rows, one column contains a row numbers, and other columns contains a character string (see col.14, lines 48-56 where the table has rows, three of them; and it has a column that contains rows numbers. Examiner considers column 2, representing the three rows numbers 1, 3 and 8); and other columns that contains a characters (see other columns that has different characters in the table in col.14, lines 48-56).

As per claim 11 Owens et al (6,338,140 B1) teach the method of claims 1 and 9 where said characters are taken from set {0-9, #, *} since it is the Examiner position that having the set of {0-9, #, *} on a telephone' key pad is inherent part of the art of telecommunication.

As per claim 12 Owens et al (6,338,140 B1) teach the calling card of claim 9 where said table has rows and more than two columns, where one column contains a row numbers, and other columns contains other numbers (see col.14, lines 48-62 where the table clearly disclose column that represent numbers and characters and it has more than one row and more than one column).

As per claim 13 Owens et al (6,338,140 B1) teach the calling card of claim 9 further comprising an alphanumeric string (see abstract; fig.9, item s120 where the accessed number is alphanumeric string; col.16, lines 58-64 see the example *66 15 7 86 #202 555 1212).

As per claim 14 Owens et al (6,338,140 B1) teach the calling card of claim 13 where said alpha-numeric string is related to an ID that is related to the numbers in said table (see col.16, lines 36-66 where the relationship between the alpha-numeric string number in line 60 is related to the random PIN related to the specific number).

14. **Claims 15-17** are rejected under 35 U.S.C. 103(a) as being unpatentable over Owens et al (6,338,140 B1) in view of AAPA; and further view of Walker et al (6,325,284 B1).

As per claims 15-17 Owen teach all limitations of the claim but do not disclose having a transparent collimating layer on said card, magnifying and narrowing field view. However Walker et al (6,325,284 B1) teach transparent collimating layer on said card, magnifying and narrowing field view (see fig.2, 6, 8 and 10 where the card has a LCD that based on the time set magnify a message based on the ambient light and after time is expired it is narrowed to a point that is not being able to be read. It would have been obvious to one of ordinary skilled in the art to utilize mark's message projection on the card's LCD in Owen's method and system in view if AAPA in order to generate power to the card when there is an activity with respect to display of a message or identification code.

Allowable Subject Matter

15. Claim 8 is allowed.

The prior art, taken singly or in combination does not teach or suggest the relationship between these features: a method of authorizing provision of service to a user comprising the step of: receiving a ID from said user; accessing a database to retrieve N ordered lists of characters associated with said ID, where N is an integer; generating a predetermined number of random variables; for each random number created in said step of generating (d) requesting said user to provide a responsive string of characters that is related to said random number, (e) receiving said responsive string of characters from said user, and (f) flagging a number in said N ordered list corresponding to said random number; and authorizing said provision of service when the set of responsive numbers received in response to a challenges matches a corresponding set of flagged number in any of said N ordered lists of numbers, provided that said service is a permitted service for a user who is associated with the ordered list that matches.

16. Claim 5 and 6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Zand whose telephone number is (703) 306-4169. The examiner can normally reached on Monday-Thursday (8:00-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (703) 305-1830. The fax phone numbers for the organization where this application or proceeding is assigned as (703) 872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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04/02/04

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